

Remarks

This Amendment is in response to the Office Action dated December 24, 2003.

Claim 17 has been amended.

Rejection based on 35 USC § 101

Claims 3-5 were rejected as being non-statutory subject matter by positively reciting part of a human. It is noted that case law has consistently held that all methods in which subject matter treated is a human body and the object is a surgical purpose are not unpatentable subject matter merely because they involve treatment of a human body. See, for example, *Ex parte Scherer*, 103 U.S.P.Q. 107 (BdPatApp&Int 1954). The method claims herein are not claiming a human body and there is no apparatus or device claim of which a portion is a human body. The rejection is respectfully traversed.

Rejection of Claims Under § 103

Claims 1, 3-13, 15-20 and 25 were rejected as being obvious over the combination of Cragg, U.S. Patent 6,558,390 ('390) in view of Kuslich, U.S. Patent 5,549,679. Prior Office Actions raised Kuslich, U.S. Patent 5,571,189 (division to US 5,549,679) as a basis of rejections which have been overcome previously.

Cragg is relied upon as the primary reference as teaching methods of treating bone abnormalities using the steps of exposing an area of bone (Figs. 27-31); the abnormality being compression fractures of the spine; forming a cavity in the bone; inserting and expandable empty fabric bag into the cavity, the bag having a fabric wall; and packing the bag through a fill opening

with material that will support or promote bone growth, the bag having openings to prevent passing from the bag (Cols. 32-33, lines 25-67, lines 1-19). It is contended that Cragg teaches all elements except for bag opening sizes which the secondary reference Kuslich US 5,549,679 teaches.

Cragg '390 was filed on February 13, 2001 based on earlier provisional patent application 60/182,748 filed on February 16, 2000. The current application was filed on July 20, 2001 based on earlier provisional application number 60/219,853 filed July 21, 2000.

A careful review of the Cragg provisional patent application shows that the disclosure relied upon by the Examiner in making the rejection in Figs. 27-31 concerning balloon assisting vertebroplasty and column 32, lines 25-67 and column 33, lines 1-19 did **not** appear in the provisional application. Therefore, the disclosure relied upon has an effective filing date of only February 13, 2001. Since applicants' filing date is July 21, 2000, the reference is **after** the invention of applicants and may not be relied upon as a prior art reference for the matter indicated. A copy of the Cragg provisional application is attached for the Examiner's review.

It is respectfully submitted that the remaining disclosure combined with the secondary reference does not teach or suggest the invention as claimed. The rejection is traversed.

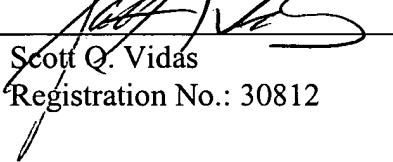
Conclusion

In view of the foregoing it is believed that the present application, with claims 1, 3-10, 11-13, 15-20 and 25 is in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: March 24, 2004

By: 
Scott Q. Vidas
Registration No.: 30812

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9185
Telephone: (952) 563-3000
Facsimile: (952) 563-3001

Enclosure: Copy of Cragg Provisional application

f:\wpwork\squ\09156us02_amd_20040324.doc